

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHRIDHAR P. JOSHI

Appeal No. 2007-0943
Application No. 09/965,163
Technology Center 3700

Decided: August 3, 2007

Before TERRY J. OWENS, HUBERT C. LORIN, and STUART S. LEVY,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, and 38.¹ 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ Claims 2, 5-13, 15, 17, 19, and 22-26 have been cancelled. Claims 28-36 and 39 have been withdrawn.

The invention is directed to a method of playing a gaming machine and a gaming machine “for dispensing a sweepstakes entry in response to predetermined criteria” (Specification 2:4-5). According to claim 1 (see below), the criteria are “at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day.” The Specification admits that gaming machines are known (Specification 2:8-10). The invention seeks to make gaming machines more entertaining by having the gaming machine dispense a sweepstakes entry form when certain conditions are triggered. “The sweepstakes entry is filled out by the player and submitted to a sweepstakes provider for a subsequent drawing” (Specification 2:23-24).

The claims are rejected as follows:

- Claims 1, 14, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Moody (US 2002/0093136 A1) in view of Brune (US 5,851,148) and Brandstetter (US 2003/0036427 A1);
- Claims 3-4, 16, and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Moody in view of Brandstetter and Horniak (US 2003/0100362 A1); and,
- Claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Moody in view of Brune, Brandstetter, and Erlichson (US 2001/0039513 A1).

We AFFIRM.

The Brief² separately argues the following groups of claims:

- Claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, 38 (Br. 7-12); and,

² Our decision will make reference to Appellants’ Appeal Brief (“Appeal Br.,” filed Jun. 15, 2006), the Examiner’s Answer (“Answer,” mailed Sep. 6, 2006), and Appellants’ Reply Brief (“Reply Br.,” filed Nov. 6, 2006).

- Claim 38 (Br. 12-14).

I. Claims 1, 14, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Moody in view of Brune and Brandstetter (US 2003/0036427 A1)

Pursuant to the rules, the Board selects representative claim 1 to decide the appeal with respect to this group of claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006). It reads as follows:

1. A method of playing a gaming machine, comprising:
 - receiving a wager to initiate play of a game on the gaming machine;
 - randomly selecting an outcome for the game from a plurality of possible outcomes;
 - awarding a monetary payout from the gaming machine for a winning outcome;
 - dispensing a tangible sweepstakes entry form from the gaming machine in response to a predetermined triggering condition, said triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day;
 - completing the tangible sweepstakes entry form manually with identifying indicia;
 - submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine; and
 - conducting the sweepstakes after the sweepstakes entry form is dispensed from the gaming machine.

A. Issue

Appellant contends that (1) the prior art does not teach or disclose the claimed triggering events that trigger the gaming machine to dispense the sweepstakes entry (Appeal Br. 8-9) and (2) there is no motivation or suggestion to combine the references that would lead one of ordinary skill in the art to the

claimed dispensing of a sweepstakes entry form in response to the claimed triggering conditions (Appeal Br. 9-12).

The issue is whether Appellant has shown error in the rejection of the claims over the prior art.

B. Finding of Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. All the claims are rejected over at least Moody and Brandstetter.
2. Moody discloses a gaming machine which receives a wager to initiate play of a game, randomly selecting an outcome from a plurality of possible outcomes, awarding a monetary payout from the gaming machine and dispensing a sweepstakes entry form (Moody [0025]). The dispensing of the sweepstakes entry form is triggered by, for example, when a player achieves certain “a combination of symbols on a pay line” (Moody [0030]).
3. The claims describe a method whereby a gaming machine receives a wager to initiate play of a game, randomly selects an outcome from a plurality of possible outcomes, awards a monetary payout from the gaming machine and dispenses a sweepstakes entry form. The sweepstakes entry form is dispensed upon a triggering of a condition by the gaming machine, including in response to “a number of activated pay lines” (claim 1).
4. Moody does not disclose the claimed steps of manually completing the sweepstakes form, submitting the sweepstakes entry form without involving the

gaming machine, and conducting the sweepstakes.

5. The Examiner found that

Brandstetter et al. teaches the following:

Completing the tangible sweepstakes entry form manually with identifying indicia (paragraphs 19-21 and 37 and summary) as recited in claims 1, 14, 18, and 27. By completing a sweepstakes entry form manually, one of ordinary skill in the art would provide game players a chance at a supplemental award to there [sic, their] initial gaming award.

(Answer 4-5).

6. Appellant does not dispute the Examiner's characterization of what Brandstetter discloses (Appeal Br. 7-12).

C. Principles of Law

1. What a reference teaches is a question of fact. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1579 n.42, 1 USPQ2d 1593, 1606 n.42 (Fed. Cir. 1987).
2. Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459,

467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

D. Analysis

Moody discloses all the claimed steps but for the steps of manually completing the sweepstakes form, submitting the sweepstakes entry form without involving the gaming machine, and conducting the sweepstakes (FF 2-3). These steps are shown in Brandstetter (FF 5-6). The claimed method appears to be the combination two known methods, Moody’s gaming method which includes dispensing a sweepstakes form and Brandstetter’s sweepstakes method. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). No secondary considerations have been submitted. Accordingly, we find the claimed combination would have been obvious to one of ordinary skill in the art at the time the invention was made.

Appellant argued that no reference the Examiner cited shows the claimed condition that triggers the gaming machine to dispense a sweepstakes form (Appeal Br. 8-9). We disagree. Moody describes the triggering condition as the response to “a combination of symbols on a pay line” (Moody [0030]). We see no difference between the condition Moody describes and the condition claimed, i.e.,

in response to “a number of activated pay lines,” which encompasses a single activated pay line (claim 1). In both instances, the trigger event is an activated pay line.

We note that Appellant’s argument focuses on Brune. However, we find Moody sufficient to show the claimed triggering event. Brune is cumulative on that point. Accordingly, the Board is relying on less than all of the references the Examiner applied. But that does not warrant a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263,266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 150 USPQ 441,444 n.2 (CCPA 1966).

Appellant also argued that there is no motivation to combine the references (Appeal Br. 9-12). However, we repeat, the Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). Here the elements of the claimed method are taught in Moody and Brandstetter. They function precisely as set forth in the references. The result – the dispensing of a sweepstake form to then be entered in a sweepstakes – is predictable to one of ordinary skill in the art with the references in hand. Since Appellant has not shown anything unexpected from the claimed combination, we find the claimed subject matter to be obvious.

The rejections of the claims are affirmed.

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claims.

II. Claims 3-4, 16, and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Moody in view of Brandstetter and Horniak (US 2003/0100362 A1)

The Appeal Brief does not separately address this rejection. Appellant argues in support of the patentability of claims 3-4, 16, and 20-21 for the same reasons used in support of the patentability of claims 1, 14, 18, and 27 (Appeal Br. 7). Accordingly, we do not separately address the rejection of claims 3-4, 16, and 20-21, but, rather, consider it to stand or fall with the disposition of the rejection of claims 1, 14, 18, and 27. Since we have found that Appellant has failed to show that the Examiner erred in rejecting claims 1, 14, 18, and 27, we likewise find that Appellant has failed to show that the Examiner erred in rejecting claims 3-4, 16, and 20-21.

III. Claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Moody in view of Brune, Brandstetter, and Erlichson (US 2001/0039513 A1)

Claim 37

The Appeal Brief does not separately address this rejection. Appellant argues in support of the patentability of claim 37 for the same reasons used in support of the patentability of claims 1, 14, 18, and 27 (Appeal Br. 7). Accordingly, we do not separately address the rejection of claim 37, but, rather, consider it to stand or fall with the disposition of the rejection of claims 1, 14, 18, and 27. Since we have found that Appellant has failed to show that the Examiner erred in rejecting claims 1, 14, 18, and 27, we likewise find that Appellant has failed to show that the Examiner erred in rejecting claim 37.

Claim 38

Claim 38 reads as follows:

38. The method of claim 37, wherein the web site has a security access code for allowing access to the website.

A. Issue

Appellant contends that the cited prior art fails to show a “security access code” for allowing access to the website (Appeal Br. 12-14).

The issue is whether Appellant has shown error in the rejection of claim 38 over the prior art on the grounds the cited prior art fails to show a “security access code” for allowing access to the website.

B. Finding of Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. Erlichson discloses the following:

The communication between CCD [client computing device] 100a. CCD 100b and Web server 240 may be secured by any Internet security protocol, such as Secured Sockets Layer (“SSL”).

(Erlichson [0030]).

2. The use of security access codes is a common way to secure the communication between a client computer and a web server.

C. Principles of Law

The Principles of Law set forth above are incorporated herein.

D. Analysis

Appellant argued that the prior art fails to show the use of security codes to access the web site. However, Erlichson shows the use of security protocols in accessing the web on a client computer (FF 1). Erlichson suggests maintaining a secure environment when accessing websites on the internet. The use of security codes as a means for securing access to a website is well known in the art. One of ordinary skill with Erlichson in hand would foresee using access codes to maintain a secure environment when accessing the website.

Appellant argued that Erlichson does not mention the words “secure,” “access,” and “code.” However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

We find that the use of security access codes to access a website would have been obvious to one of ordinary skill in the art reading Erlichson.

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting claim 38 over the prior art.

DECISION

The Examiner's rejections of claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, 38 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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